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CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Hoover Company
v.
Royal Appliance Mfg. Co.

Opposition No. 96,834
to Application No. 74/462,460
filed on November 23, 1993

Ray L. Weber and Sylvia A. Petrosky of Renner, Kenner,
Grieve, Bobak, Taylor & Weber for opposer.

Patrick R. Roche, Sandra M. Koenig and Jude A. Fry of Fay,
Sharpe, Beall, Fagan, Minnich & McKee for applicant.

Before Cissel, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

The Hoover Company filed its opposition to the
application of Royal Appliance Mfg. Co. to register the
mark THE FIRST NAME IN FLOORCARE for "electrical vacuum

cleaners for both domestic and industrial use," in International Class 9.¹ The application includes a disclaimer of FLOORCARE apart from the mark as a whole.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used mark, NUMBER ONE IN FLOORCARE, for "electric vacuum cleaners" as to be likely to cause confusion, under Section 2(d) of the Trademark Act. Additionally, opposer asserts that applicant's mark is deceptive, under Section 2(a) of the Trademark Act, or deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, in connection with the recited goods "because it is a false statement which bestows upon applicant's [products] an appearance of greater quality or salability to which the goods are not entitled"; and that such an appearance "is likely to materially affect consumer decisions to purchase said goods."

Applicant, in its answer, denied the salient allegations of the claim. Although applicant asserted as an "affirmative defense" that opposer "is estopped from proceeding with this opposition because it has abandoned its NUMBER ONE IN FLOORCARE trademark through nonuse,"

¹ Application Serial No. 74/462,460, filed November 23, 1993, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of April 29, 1992.

applicant did not pursue this claim and, thus, we consider it to be waived and we have given applicant's claim of abandonment based on nonuse no consideration.

The Record

The record consists of the pleadings; the file of the involved application; various specified responses of applicant and opposer to interrogatories and requests for admissions, made of record by opposer's and applicant's notices of reliance²; and the testimony depositions by opposer of David A. Gault, opposer's vice president of marketing, A. Burgess Lowe, opposer's patent counsel, Jacquelyn B. Love, opposer's publications manager, and Ann B. Haines, with opposer's historical center, all with accompanying exhibits. Both parties filed briefs on the case and an oral hearing was held.

We note, at the outset, that applicant has raised objections to several exhibits submitted by opposer. In particular, applicant has objected to opposer's Exhibit 1, consisting of photographs, on the grounds of lack of foundation and authenticity. We find opposer's witness,

² Applicant submitted its own answers to opposer's interrogatories without any indication that this submission is responsive to opposer's submission. A party may not submit its own answers to interrogatories, absent consent, unless it is to respond to or supplement the other party's partial submission of the same. However, as opposer has not objected, we have considered this submission as part of the record.

Mr. Gault, to be competent to testify on behalf of opposer regarding the subject matter of these photographs. The notes contained thereon are adequate to establish the locations and dates of the labeled pictures. Those photographs that are undated are of minimal evidentiary value and have been so considered.

Applicant objects to opposer's Exhibit 18, consisting of copies of invoices and a list of sales totals for opposer's display cubes, on the grounds of hearsay and relevancy and, under Fed. R. Evid. 1006, contending that opposer has not made available to applicant the documents underlying this compilation of figures.³ Applicant's contentions are not well taken and we have considered this evidence, including any inconsistencies apparent in the compilation.

Applicant's remaining evidentiary objections to specified exhibits go to, essentially, the probative value of opposer's evidence, rather than to its admissibility. Applicant describes the evidence to which it objects broadly as "surveys" and contends that the foundation and reliability of the purported surveys have not been

³ Applicant's objection to this exhibit under Fed. R. Evid. 1006 is that opposer has not made available to applicant the documents underlying this compilation of figures. However, applicant has not indicated that it requested and was denied such documentation.

adequately established. However, the majority of these exhibits are articles from various newspapers and trade publications regarding product rankings in the floorcare industry rather than surveys. Other exhibits are studies and/or surveys, some undertaken independently and some at opposer's request, but not in connection with this proceeding. All of this evidence was presented through the testimony of Mr. Gault. Mr. Gault testified that these studies pertain to industry rankings, trends and consumer information; that the studies commissioned by opposer were conducted as part of the regular course of opposer's business; and that his company makes business decisions based in part on the results of the studies commissioned by opposer. We find applicant's objections to this evidence to be without merit and we have considered the evidence for whatever probative value it may have. Certainly, this evidence is hearsay for the truth of the statements contained therein. However, the exhibits are probative of consumer exposure to opposer's company name in connection with floorcare products.

The Parties

Opposer submitted a substantial amount of evidence and testimony regarding its long history as a manufacturer of vacuum cleaners and establishing the company's renown. The

evidence reflects opposer's prominence in the field, focusing on its history manufacturing various models of vacuum cleaners for domestic use since 1910, and noting that opposer, through its predecessor-in-interest, was the first company to manufacture and commercially distribute electrical vacuum cleaners. Similarly, applicant has manufactured and distributed vacuum cleaners, principally for domestic use, since 1912.

Opposer's witness, David Gault, testified that "floorcare" is a term commonly used to describe products for the care of floors, in particular, upright, stick and canister vacuum cleaners, wet and dry vacuum cleaners and hand cleaners; that opposer and applicant manufacture and sell similar lines of floorcare products for domestic use; that opposer and applicant sell their products within essentially the same price ranges to the same classes of purchasers; and that opposer and applicant sell their products nationally through the same national retailers, such as Wal-Mart, K-Mart, Sam's Club and Sears. Mr. Gault stated that, during his thirty-year tenure with opposer, Hoover has been first among manufacturers of floorcare products for brand recognition and sales of its floorcare products.

It is clear from the evidence that opposer's principal trademark is the "Hoover" name and that this is a well-known trademark. Mr. Gault testified that opposer has used the slogan "Number One in Floorcare" since the mid-1970s. The evidence includes examples of the use of this slogan in 1975 specifications brochures for a variety of models of vacuum cleaners (opposer's exhibit no. 44), on advertising display mobiles in 1981 (opposer's exhibit no. 16) and, from the early 1980s to the present, on advertising cubes used as point of purchase displays by retailers (opposer's exhibit no. 1). Mr. Gault noted that the slogan is used along with the "Hoover" trademark. While Mr. Gault disclosed that opposer has spent substantial sums on national advertising of its products, opposer presented no figures regarding extent of use, consumer recognition or advertising specifically involving the slogan "Number One in Floorcare." Mr. Gault stated, unequivocally, that the slogan "Number One in Floorcare" is descriptive of the various areas wherein Hoover is "first," such as, historically, selling the first vacuum cleaner, and in terms of product sales, reliability and innovation, and consumer brand recognition and loyalty (Gault testimony, pgs. 95-98); and that consumers would perceive this slogan as describing one or more of these qualities.

Applicant's states in its response to opposer's interrogatories that it began using THE FIRST NAME IN FLOORCARE in 1992; that the slogan is used on boxes and cartons containing the goods, on point of purchase displays, on stationary, and at trade shows; and that the slogan is used along with the Royal name or, until 1996, with applicant's "Dirt Devil" brand. Both parties agree that there have been no known instances of actual confusion related to the use of their respective slogans during approximately six years of concurrent use.

Analysis

Priority and Likelihood of Confusion

In considering priority and likelihood of confusion, under Section 2(d), in this case, we must first consider the issue of the distinctiveness, either inherent or acquired, of the slogan claimed by opposer to be its mark. As our primary reviewing court noted in *Towers V. Advent Software Inc.*, 913 F.2d 942, 17 USPQ2d 1471 (Fed. Cir. 1990):

Under the rule of *Otto Roth* [*Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)], a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a

trade identity." *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43.

* * *

Section 2(d) bars registration, or serves as a basis for cancellation, if there is a likelihood of confusion as to source. As to an unregistered term, such a likelihood of confusion results when there are trade identity rights in the prior user's term. Those trade identity rights arise when the term is distinctive either inherently or through the acquisition of secondary meaning.

Applicant contends that opposer's slogan, NUMBER ONE IN FLOORCARE, is not an inherently distinctive trademark; and that opposer has not established that its slogan has acquired distinctiveness. Opposer contends, on the other hand, that its slogan is inherently distinctive; and, alternatively, that, through extensive and exclusive use, it has acquired distinctiveness. Opposer reasons, both in its brief and through the testimony of its vice president of marketing, Mr. Gault, that its designation NUMBER ONE IN FLOORCARE "is distinctive - there can only be one number one"; and that, as opposer is "the holder of the top position in every recognized category in floorcare [and] [n]o others can 'with equal truth' use such a designation," it is an inherently distinctive identifier of opposer as the source of the goods sold in connection therewith.

We agree with applicant that the slogan NUMBER ONE IN FLOORCARE is a generally laudatory phrase, as opposer's own statements indicate, and, thus, it is not inherently

distinctive. In fact, Mr. Gault admitted that consumers would perceive this slogan as describing one or more of opposer's qualities, which make it a leader in the field. However, the fact that the slogan may merely describe opposer and no one else does not render it an inherently distinctive trademark. Rather, as applicant states, opposer's slogan merely describes "certain characteristics of [opposer's] goods - that is, [opposer] is number one in floorcare in the areas of innovation, consumer brand preference, purchase intent, consumer awareness brand recognition and sales." As our primary reviewing court noted in the recent case of *In re Boston Beer Company Limited Partnership*, Appeal No. 99-1123 (Fed. Cir., December 7, 1999), *aff'g.* 47 USPQ2d 1914 (TTAB 1998), "'Marks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive ... Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods.'" 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §11:17 (4th ed. 1996)."

Thus, we turn to the question of whether opposer has established that its slogan, NUMBER ONE IN FLOORCARE, has acquired distinctiveness as opposer's trademark in connection with its floorcare products. The issue is

whether this descriptive slogan has acquired secondary meaning, that is, whether opposer's use and promotion of the slogan over a period of time has been of such a nature and extent that the primary significance of the term in the minds of the consuming public is no longer descriptive, but rather is an indication of the source of the goods of opposer. *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Opposer has provided a substantial amount of evidence about the history of its company and the "Hoover" name as a trademark for its floorcare products. However, opposer has provided meager evidence about the use of its slogan NUMBER ONE IN FLOORCARE. While opposer has provided photographs of advertising "cubes" containing the slogan as used by dealers and some figures regarding numbers of advertising cubes sold to dealers, it is impossible to determine whether this evidence translates into substantial exposure of opposer's slogan to relevant purchasers. Further, the evidence of record demonstrates use of the slogan with, or in close proximity to, opposer's principle trademark "Hoover." It would appear from this evidence that the slogan is more likely to be perceived as a laudatory statement in advertising about the goods than as a trademark. The record contains no evidence of consumer

perception or information linking opposer's slogan with use in contexts that would condition consumers to react to or recognize the designation as an indication of opposer as the source of the goods. Therefore, we conclude that opposer has not established that its slogan NUMBER ONE IN FLOORCARE has acquired distinctiveness as a trademark.

In view thereof, opposer's claim of priority and likelihood of confusion, under Section 2(d) of the Trademark Act, must fail.

Deceptive and/or Misdescriptive

Opposer contends that applicant's applied-for mark, THE FIRST NAME IN FLOORCARE, "conjures up in the minds of those seeing it the position of preeminence in the floorcare industry[,] [b]ut, Royal does not enjoy that position in any sense"; that applicant's slogan "goes far beyond puffery ... [i]t goes to a proclamation of a specific position in a specific industry"; that this claim is inaccurate, but that prospective purchasers are likely to believe it; and that "[c]onsumers generally tend to buy the products of the foremost supplier in the industry."

Applicant responds that opposer has not established that opposer or anyone else is in the "number one position in all areas in the floorcare industry" and, thus, applicant's mark is not misleading or deceptive. Applicant

also contends that its mark "makes no representations about its goods" and "it does not suggest that Royal is 'first' in any area." Rather, applicant contends that "[t]he portion of the mark THE FIRST NAME simply suggests consumer familiarity with the Royal product line ... [;] that there has been and is a friendly and longstanding relationship between Royal and the consuming public ... [;] and that Royal and a consumer are on equal footing and that Royal has earned a measure of respect from consumers."

To find that a mark is deceptively misdescriptive within the meaning of Section 2(e)(1) of the Trademark Act, the mark must misdescribe the goods in such a manner that consumers would be likely to believe the misrepresentation. *In re Quady Winery, Inc.*, 221 USPQ 1213, 12 14 (TTAB 1984). After carefully considering the record and the parties' arguments, we find that opposer has not established that THE FIRST NAME IN FLOORCARE either misdescribes or misrepresents applicant's electrical vacuum cleaners. Rather, it appears to be a phrase that vaguely suggests, as in advertising puffery, general familiarity or quality. Opposer has failed to establish that "THE FIRST NAME" would be perceived by consumers as having the same connotation as "NUMBER ONE." Applicant's contentions that "THE FIRST NAME" has connotations suggesting familiarity, as in being

on a "first name" basis, are equally reasonable. Further, even if "THE FIRST NAME" connotes a position of preeminence, it is a general connotation of preeminence - it is not clear that consumers would immediately understand the category or categories to which the phrase would or could pertain. Thus, we find that applicant's mark is not deceptively misdescriptive.

We also find that applicant's mark is not deceptive. The test for determining whether a mark is deceptive under Section 2(a) is stated by the Court of Appeals for the Federal Circuit in *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (1988):

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?

See also, *In re Woolrich Woolen Mills, Inc.*, 13 USPQ2d 1235 (TTAB 1989). Because, as discussed above in the context of misdescriptiveness, applicant's mark satisfies none of the above tests, we conclude that applicant's mark is not deceptive. This case is analogous to the case of *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1312 (TTAB 1990) (THE REAL YELLOW PAGES for classified telephone directories

held neither merely descriptive, deceptively misdescriptive nor deceptive), wherein the Board stated "the phrase as a whole appears to us to be a suggestive mark lacking in specific meaning or definite informational quality."

Decision: The opposition is dismissed.

R. F. Cissel

C. E. Walters

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board